



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,107 10/20/99 MARSHALL

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QM22/0925

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/422,107

Applicant(s)
Randall S. Marshall

Examiner
Mark T. Henderson

Group Art Unit
3722



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☒ Claim(s) 5-12 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TO 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TO 3700 will be promptly forwarded to the examiner.

Specification

1. Applicant is advised on how to arrange the content of the specification.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

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- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention

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described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The **claim or claims must commence on separate sheet**. (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.
- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a **separate sheet** following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing: See 37 CFR 1.821-1.825.

2. The abstract of the disclosure is objected to because it does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: The specification should be typed on standard 8 ½ x 11 paper, double spaced. Appropriate correction is required.

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4. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Claim Objections

5. Claims 1-4 are objected to because of the following informalities: The terms in parentheses “()” are not considered part of the claim. Therefore, “(boards)” and color “(s)” are not given any patentable weight. Appropriate correction is required.

6. Claims 5-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “marked with the use of lines, utilizing color(s), or both,...” is not understood. It is unclear to the examiner whether applicant wishes to use either lines or color, or both. The phrase “marked with use of lines, utilizing color(s) is essentially the same as the phrase “both”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lovell (5,273,281)

Lovell discloses in Fig. 4, a bet slip having boxes (A) containing numbers (B) divided into two or more positions (51 and 52) and marked with the use of lines (C) to define the positions.

9. Claims 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruin et al (WO 95/21425).

Bruin et al discloses in Fig. 2-6, a bet slip having boxes (4) containing numbers (A) divided into two or more positions (^{4.}~~51 and 52~~) and marked with the use of lines (B) and colors (colors surrounding "SOLO" and "DUO") to define the positions.

Prior Art References

10. The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for their sheet structure. Sebestyen, Langan, and Johnston disclose a bet slip having lines to define positions.

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Applicant's Response

The following consists of general information for the Applicant's benefit. Unless the Office explicitly requests the return of a paper, all papers mailed to the Applicant are intended to be kept by the Applicant for his own records. The response must be signed by ALL applicants.

I. Amendments to the Specification

Any amendments to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line numbers. No new matter may be entered.

It is not necessary to submit a new specification unless one has been required by the Examiner. An example of an amendment to the specification should appear as follows:

On page 16, line 12, change "effect" to --affect--.

On page 23, line 4, insert --bucket-- after "backhoe".

(Note: the inserted language is placed between double dashes.)

If a new specification is submitted, a marked up copy of the original specification is also required.

II. Amendments to the Drawings

Any amendment to the drawings modifying, deleting or inserting figures must be specifically requested in the amendment. Any changes must be shown in red-ink on the drawings.

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Any insertion of new figures must be set forth in the amendment and the specification must be amended in the Brief Description of the Drawings as well as in the Detailed Description of the Drawings sections in a manner as set forth above.

III. Amendments to the Claims

The amendments to the claims should be presented in the above format. If an amendment to a claim requires the addition of more than five words, the claim must be completely rewritten with the additions to the claim being underlined. Any deletions from the claims must be enclosed in brackets. No matter may be inserted into the claims that was not in the originally filed disclosure.

As an example, if a claim for a chair were originally written as follows:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

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If the specification or drawings originally described the inclusion of four legs on the chair, the new limitation of "four legs" in the claim would not constitute new matter.

IV. Arguments

If an Office Action contains a rejection or objection to the claims, the Applicant MUST respond with arguments under the heading "Remarks", pointing out disagreements with the Examiner's contentions. The Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or patentably distinguish from them. The applicant must respond to every ground of rejection and objection set forth in the Office Action. For more details of the amendment process, the Applicant can refer to 37 Code of Federal Regulations Sections 1.118 - 1.121.

V. New Matter

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

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VI. Period for Response

The three month shortened statutory period specified in the cover letter (form PTO-326) is the period of time in which the Applicant has to respond to every rejection and objection within this Office Action. The Applicant's response must be received within three months of the date listed on the cover letter, or the application will be held abandoned.

This period, however, may be extended up to a maximum of six months, with the payment of the appropriate fee. The following table lists the required fee for extensions of the three month period:

<u>No. Months after Office Action Date</u>	<u>Amount of Fee</u>
0 - 1	-
1 - 2	-
2 - 3	-
3 - 4	\$ 55
4 - 5	\$190
5 - 6	\$435

If the response is filed four months and one day after the mailing date of the Office Action, the response must be accompanied by a fee in the amount of \$190. A separate Petition for Extension of Time requesting "an extension of the period for response under 37 CFR 1.136(a)" must be submitted with the response.

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VII. Certificate of Mailing

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on (date).

(signature)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed.

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TO 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TO 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 21, 2000



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700